

REMARKS

I. Status of the Claims

Claims 1 and 12-31 were previously pending. Applicants have canceled claims 24-25 and amended claims 23 and 28. The amendment to claim 23 cancels two of the recited bases. The amendment to claim 28 inserts an “and” between the two clauses. Each of the amendments is supported in the original claim. These amendments add no new matter. Claims 1, 12-23, and 26-31 are pending.

II. Rejection Under 35 U.S.C. § 102(b)

The Office rejects claims 1 and 12-31 under 35 U.S.C. § 102(b) as allegedly anticipated by EP 0 688 772 to Kwak et al. (“Kwak”). Office Action, page 2.

According to the Office, Kwak teaches the claimed process using “aqueous mixtures of solvents such as ethanol, acetonitrile etc.” *Id.* at 3.

Applicants respectfully traverse this rejection. To anticipate a claim under 35 U.S.C. § 102, every element recited in the claim must be disclosed in the reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”) Further, a reference must “clearly and unequivocally disclose the claimed [composition] or direct those skilled in the art to the [composition] without any need for picking, choosing, and combining various disclosures” *In re Arkley*, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972).

Claim 1 and its dependent claims, claims 12-22, recite that the solvent is water.

Claim 23 and its dependent claims, claims 26-31, recite that the base is a tetraC₁₋₆alkylammonium hydroxide. The Office acknowledges in rejecting these same claims under 35 U.S.C. § 103(a) that the claims differ from Kwak in reciting that the aqueous solvent is water. Office Action, page 4. Likewise, Kwak does not teach that the base used in its processes can be a tetraC₁₋₆alkylammonium hydroxide. All of the claims therefore recite at least one element that is missing from the teachings of Kwak.

Accordingly, Kwak does not anticipate the claims and Applicants respectfully request that the Office withdraw the rejection.

III. Rejection Under 35 U.S.C. § 103(a)

The Office also rejects claims 1 and 12-31 under 35 U.S.C. § 103(a) as allegedly unpatentable over Kwak in view of EP 0 183 129 to Irikura et al. ("Irikura"). Office Action, page 3. The Office relies on Kwak as teaching "the instant claimed process using aqueous mixtures of solvents such as ethanol, acetonitrile, etc." *Id.* at 4. Irikura is said to teach "the same types of reaction" and that "solvents such as water, alcohols, and acetonitriles may be used". *Id.* In this rejection, the Office acknowledges that Kwak does not teach water as a solvent, *id.*, but it goes on to find that water was an obvious alternate solvent in view of the teachings of Irikura, *id.* at 5.

Applicants traverse the Office's position. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." M.P.E.P. § 2142. The *prima facie* case of obviousness must meet several essential criteria, including that the prior art references must teach or suggest all of the claim limitations, and that there

is some reason, suggestion, or motivation in the prior art to lead one of ordinary skill in the art to combine the teachings of the references in the manner proposed by the Office. M.P.E.P. § 2143. That suggestion or motivation must be found in the prior art, not in the Applicant's disclosure. *Id.* Further, without a clear and particular reason to combine or modify the teachings of the references, the identification of the individual elements of a claimed invention in the prior art is not sufficient to negate patentability. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998).

In this case, Kwak does not teach using water as the solvent, as recited in claim 1. Kwak also does not suggest using water. Instead, that reference uses acetonitrile in its examples and teaches in paragraph [0029] that preferred solvents for use in the recited process are acetonitrile, DMF, DMSO, pyridine, and HMPA. Irikura also uses acetonitrile, or β -picoline, in those examples that involve substitution of a leaving group by a pyrrolidine. And although Irikura teaches that water is one of several possible solvents, that reference does not provide any reasons that the ordinary artisan would have been motivated to select water from the solvents mentioned in Irikura and substitute it for the acetonitrile used in Kwak, or for any of the other solvents that Kwak suggests.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). Here, nothing in the teachings of the references, or set forth in the

Office's statement of the rejection, suggests the desirability of the combination that the Office proposes.

In addition, neither Kwak nor Irikura teach or suggest the desirability of using tetraC₁₋₆alkylammonium hydroxide as the base, as recited in claim 23. Because the Office has not provided any clear and particular reasons why one of ordinary skill in the art would have been motivated to modify the teachings of Kwak, Applicants respectfully submit the rejection is in error. Accordingly, they request the Office to withdraw it.

Conclusion

In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: *Stev P. O'Connor*
Steven P. O'Connor
Reg. No. 41,225
(571) 203-2718